

Application No. 10/763,268  
Amendment dated  
Reply to Office Action of June 16, 2006

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Docket No.: 21581-00160-US3

### REMARKS

Claims 12-30, 38-49 and 51-56 are pending in the present application. The allowance of claims 38-49 is hereby noted with appreciation. Claims 12, 13, 22, 38, 55 and 56 have been amended to correct minor clerical errors for purposes of clarification and not to limit their scope. In particular, claim 12 has been amended by reciting "an" in place of "a" and claim 55 has been amended by deleting a superfluous "the" and correcting the spelling of "from". Claims 12, 13, 22, 38, 55 and 56 have been amended by removing the redundancy of the word "at". The amendments to the claims do not introduce any new matter or raise any new issues.

Claims 12-30 and 52-56 were rejected under 35 USC 102(e) as being anticipated by or in the alternative, under 35 USC 103(a) as being obvious over US Patent 5,986,014 to Kusakabe et al.. Claim 51 was rejected under 35 USC 102(e) as being anticipated by US Patent 5,986,014 to Kusakabe et al. (hereinafter also referred to as "Kusakabe"). Kusakabe does not anticipate and does render obvious claims 12-30 and 51-56.

The statement in the office action that the "Statement of Common Ownership is not effective since the filing date and patent date of the prior art reference (US Patent 5,986,014), are prior to November 29, 1999" is an incorrect interpretation of the law. In particular, it is not the filing date of the prior art reference that is pertinent but the filing date of the present application which is after November 29, 1999. The patent statute was changed and made effective with respect to rejections under 35 USC 103 involving 35 USC 102(e) in applications filed on or after November 29, 1999. The present invention should not be rejected under 35 USC 103(a) by Kusakabe et al. (U.S. Patent 5,986,014). Accordingly, the rejection under 35 USC 103(a) can not stand.

With respect to claims 13-21 and 53, the Examiner recognizes, that the formula (5) in claim 13 of the present invention (such as  $-\text{CH}_2-\text{CH}_2-\text{CH}(\text{COOR})-\text{CH}_2-\text{CH}=\text{CH}_2$ ) differs from the formula (D):  $-\text{CH}_2-\text{CH}(\text{COOR}^2)-\text{CH}_2-\text{CH}=\text{CH}_2$ , which is obtained by reacting the formula (1) with the formula (3) of Kusakabe, in view of an additional methylene group.

Therefore, Kusakabe discloses neither the vinyl polymer having an alkenyl group of the formula (5) of the above claims nor the curable composition containing the vinyl polymer.

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Accordingly, the present invention as defined in claims 13-21 and 53 differs from the suggestions of Kusakabe and it is novel.

Concerning claims 22-30, 54 and 56, as appreciated by the Examiner, the formula (6) in claim 22 of the present invention differs from the formula (A), which is obtained by reacting the formula (1) with the formula (7) of Kusakabe, in view of an additional methylene group. Moreover, the Examiner refers to formula (B), wherein  $R^8$  is  $-\text{CH}_2-\text{C}(\text{O})\text{O}-$ , as the formula (6) of the present invention. However, the formula (6) in claim 22 does not contain the group  $-\text{CH}_2-\text{C}(\text{O})\text{O}-$  as  $R^8$  since  $R^8$  is defined as a direct bond or a divalent organic group having 1-10 carbon atoms and optionally containing one or more ether bonds (not ester bonds). In addition, Kusakabe seems to react the formula (1) with the formula (6), and the obtained crosslinkable silyl group of Kusakabe also differs from formula (6) in claim 22 of the present invention.

Therefore, Kusakabe fails to disclose a vinyl polymer having a crosslinkable silyl group of the formula (6) of the present invention or a curable composition containing the vinyl polymer. Furthermore, Kusakabe does not disclose the method of the present invention for preparing the novel vinyl polymer having a crosslinkable silyl group of the formula (6) by using the novel vinyl polymer of claim 13. Accordingly, the present invention differs from Kusakabe, and it is novel.

Concerning claims 12, 51-52 and 55, the Examiner mentions that the partial structure  $(-\text{CH}_2-\text{CH}_2-\text{O}-\text{CH}=\text{CH}_2)$  of the formula (2):  $\text{CH}_2=\text{C}(\text{R}^3)-\text{R}^4-\text{CH}_2-\text{CH}_2-\text{O}-\text{CH}=\text{CH}_2$  of Kusakabe is equivalent to the formula (1) ( $\text{R}^1, \text{R}^2$ : a hydrogen,  $\text{R}^3$ : a single bond) in claim 51 of the present invention. However, since  $\text{R}^3$  of the formula (1) does not represent a single bond in claims of the present invention, the conclusion in the office action is not correct. Even if the formula (1) of the present invention is compared to an alkenyl group obtained by reacting the formula (1) with the formula (2) of Kusakabe, the formula (1) of the present invention differs from the alkenyl group obtained by reacting the formula (1) with the formula (2) of Kusakabe. The formula (1) of the present invention differs from the alkenyl group obtained in Kusakabe.

Therefore, Kusakabe does not disclose the vinyl polymer having an alkenyl group of the formula (1) of the present invention or the vinyl polymer having a crosslinkable silyl group obtained by using the vinyl polymer having an alkenyl group. Moreover, Kusakabe does not disclose the curable composition of the present invention containing the above novel vinyl

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polymer or the method of the present invention for preparing the novel vinyl polymer having a crosslinkable silyl group by using the novel vinyl polymer having an alkenyl group.  
Accordingly, the present invention differs from Kusakabe, and it is novel.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

In the event that the Examiner believes that another interview would serve to advance the prosecution of this application, the undersigned is available at the number noted below.

Please charge any fees due with this response or credit any overpayment to our Deposit Account No. 22-0185, under Order No. 21581-00160-US3 from which the undersigned is authorized to draw.

Dated: 10-10-06

Respectfully submitted,

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